> To support the claim language of "consisting essentially of," Applicants are required to provide data showing that the introduction of additional components would alter the characteristics of Applicants' invention. Applicants have not provided factual evidence to substantiate the arguments that other components would materially affect the basic and novel characteristics of the presently claimed invention. See MPEP 2111.03 [and cases cited therein].

MPEP 2111.03 does not, however, imply that providing data is the only way to show that the addition of polyvinyl butyral would materially affect the basic and novel characteristics of the claimed invention. Other forms of evidence can be used.

Under MPEP 2111.03, the first step in the analysis is to identify the basic and novel characteristics of Applicants' invention. As stated on page 3, lines 13-18 of Applicants' specification:

> The fibers of this invention lack melt elasticity compared to other polypropylene/impact modifier blends, thereby avoiding any "roping" during the manufacturing process. The impact modifier used in this invention creates a plasticizing effect that allows the polypropylene chains to slip more easily. Another attribute of the fibers of this invention is improved fabric softness resulting from the addition of impact modifier (emphasis added).

Thus, the basic and novel characteristics of the impact modified fibers are the lack of melt elasticity combined with plasticization and improved fabric softness. A prior art additive which undermines or defeats this combination of properties would be excluded by the "consisting essentially of" claim language.

The second step in the analysis is to examine Applicants' specification for evidence of whether or not these characteristics actually exist in the claimed composition. For textile fibers used in making various fabrics, softness is an important product property. The above-described plasticization effect contributes to softness by reducing the hardness and brittleness of fibers. The above-described lack of melt elasticity contributes to softness by reducing roping and entanglement of fibers (p. 26 lines 14-21).

As explained in Applicants' specification, softness can be measured using the Cup Crush Test (p. 31 line 23 – p. 32 line 16). Lower cup crush values define

improved softness. As shown in Tables 2, 5 and 6 of the Examples, fibers made using the impact modified polypropylene blends of the invention had improved softness (reflected in lower cup crush loads and energies) compared to the Control fiber samples. Thus, the specification provides clear evidence that improved softness (combined with other supporting features) is a basic and novel characteristic of the claimed impact modified fibers.

Under MPEP 2111.03, the final step is to examine all available evidence that the addition of polyvinyl butyral as disclosed in Gutweiler et al. would materially affect the basic and novel characteristics (especially the softness) of Applicants' impact-modified fibers. Such evidence is explicitly set forth in the Gutweiler et al. disclosure:

> This invention relates to a polypropylene molding composition of good hardness... (Col. 1 lines 5-11, emphasis added).
>
> The molding composition according to the invention results in moldings which are distinguished by a good ability to be coated (without the customary pretreatment), in combination with good hardness and impact strength, in particular also at temperatures below 0° C. Generally, this molding composition can be used for the production of extruded, injection-molded, foamed or blow-molded shaped articles in all instances where a high rigidity, hardness, tear and flexural strength, dimensional stability and scratch resistance in combination with a high impact strength... are desirable (Col. 3 lines 42-53, emphasis added.

While the impact-modified polypropylene fibers of Applicants' invention are characterized by improved softness, a primary objective of Gutweiler et al. is to provide polyvinyl butyral-containing compositions having high rigidity and hardness. The stated features of high rigidity and hardness would plainly defeat, and/or materially affect, the improved fabric softness achieved by Applicants.

When a reference so vehemently conveys that a prior art composition does not embody the basic and novel characteristics of Applicants' invention, it is improper for the Examiner to require test data that proves the prior art reference means exactly what it says. The Examiner has provided no evidence that the disclosure of Gutweiler et al. is

wrong, and has no basis for assuming that the polyvinyl butyral-containing compositions are soft, instead of hard and brittle.

A case on point is In Re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA, 1964). At issue was whether or not a claimed glass composition "consisting essentially of" recited ingredients excluded small amounts of carbon and sulfur recited in a prior art U.S. Patent 2,243,142 to Lyle. The basic and novel feature of the claimed glass composition was desirable electrical insulation. The Examiner had alleged that Applicant had the burden of showing that the prior art Lyle composition did not possess this feature.

In finding for the Applicant, the Court stressed the lack of evidence supporting the Examiner's position:

> In the total absence of evidence in the record that the amber glass disclosed by Lyle would be expected to have desirable electrical insulating properties, we can find no justification for placing the burden on applicant to conduct experiments to determine the insulating properties of the colored glass disclosed by Lyle. Although there are only slight differences between the Lyle composition and that sought to be patented, we cannot assume that these small differences are incapable of causing a difference in properties. Appellant, in showing that his glass has basic and novel properties (at least as far as the record is concerned) would appear to have met his burden. 143 USPQ at 259 (emphasis added).

As further stated by the Court, the Examiner has the burden of establishing a motivation for modifying the prior art reference to make the claimed invention:

> We do not feel that a rejection based upon the premise that the differences between appellant's glass and the Lyle glass are obvious can be sustained. Admittedly, the differences are small, but Lyle is devoid of any suggestion of a glass embodying these differences. The Examiner has failed to suggest any reason for omitting carbon and sulfur from the Lyle glass. 143 USPQ at 259 (emphasis added).

In the instant prosecution, the Examiner has produced no evidence that the impact-modified polypropylene of Gutweiler et al. possesses improved softness, which is a primary feature of Applicants' claimed composition. Gutweiler et al. teaches that the opposite is true, and the disclosed composition is hard and brittle. Furthermore, the

Examiner has provided no motivation to omit the polyvinyl butyral from the prior art composition.

For these additional reasons, the rejection under 35 U.S.C. § 103(a) should be withdrawn. Also, Applicants maintain their traversal of the restriction requirement for the reasons stated in Amendment G, filed 12 January 2006, which is being considered along with this supplemental response.

Respectfully submitted,

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